REMARKS

All pending claims 1-16 were rejected in second Office Action. For the following reasons, withdrawal of the rejections is respectfully requested.

Drawings

The drawings were objected to under 35 C.F.R. §1.83(a). The Examiner indicated that the cylindrical core member must be shown or the feature should be canceled from the claims. Accordingly, the cylindrical core member has been canceled from independent claims 1 and 11. Dependent claim 6 has been amended to correct antecedent issues stemming from the cancellation of the cylindrical core member from claim 1. No new matter is hereby entered. The Examiner's acceptance of these changes is respectfully requested.

Claims Rejections in View of Pall

The Office Action rejected claims 1-6 and 9-14 under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Pall, U.S. Patent No. 3,933,557. The Office Action rejected claims 7-8 and 15-16 under 35 U.S.C. §103(a) over Pall. However, Pall does not teach or otherwise render anticipated or obvious the subject matter of these claims. The Office Action states that Pall does not disclose the property or function of the non-woven filter cartridge having "an efficiency in removing 1 micron particles greater than or equal to at least about 99.9%, and wherein a pressure drop across the filter cartridge is less than about 3 pounds per square inch for every gallon per minute of flow through a 10 inch long section of the filter cartridge," as recited in independent claim 1 and similarly recited in independent claim 11. The Office Action states that "[t]the examiner cannot determine whether or not the reference inherently possesses the properties which anticipate or render obvious these properties or functions of the claimed invention, and has basis for shifting the burden of proof to applicants." However, "the initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention rests

upon the examiner." *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1463-1464 (Bd. Pat. App. & Inter. 1990). The burden shifts to the Applicants only after the Examiner has discharged the initial burden. *Ex parte Levy*, 17 U.S.P.Q.2d at 1464. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily flows* from the teachings of the applied prior art." *Ex parte Levy*, 17 U.S.P.Q.2d at 1464 (*emphasis in original*). "Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient." *In re Oelrich and Divigard*, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (emphasis in original). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill'." *In re Robertson*, 49 U.S.P.Q.2d 1949, 1950-1951 (Fed. Cir. 1999). The Examiner must first provide a rationale or evidence tending to show inherency. Only after the Examiner provides evidence or reasoning tending to show inherency does the burden shift to the Applicant to provide proof that the reference does not inherently possess the claimed properties. M.P.E.P. § 2112.

The Examiner has not discharged this initial burden because the evidence does not make clear that the claimed properties are *necessarily present* in the Pall reference. Therefore, the burden of proof does not shift to Applicants. Further, regarding independent claims 1 and 11, evidence in the Pall reference does not support a finding of inherency. In Table 1, which spans columns 15 and 16, the last row is labeled "Element is 99% efficient at microns" and lists Run No. 1 at 2.0 microns, Run No. 2 at 1.5 microns and Run No. 3 at 1.5 microns. A teaching that a filter element is 99% efficient at 1.5 microns or greater does not suggest an element which is at least about 99.9% efficient at 1 micron, as claimed. In view of the foregoing, claims 1 and 11 are allowable as not anticipated or rendered obvious by Pall. Claims 2-10 depend from claim 1 and are likewise patentable. Claims 12-16 depend from claim 11 and are similarly patentable.

Further, regarding claims 5, 7, 11 and 15, Pall does not teach or suggest a calendered layer as claimed. The application specification teaches that the calendered layer results from the

compression of filaments. (Page 12, line 6-8). As shown in FIG. 2A and discussed in the specification, as the filaments from filament mass 114a are drawn past nip 122, they are compressed between nip 122 and mandrel 110 to form a dense layer of the very small diameter filaments produced in filament pattern 114. (Page 11, lines 1-4). "Calendered" means "to press between rollers for the purpose of making smooth and glossy, or wavy, as woolen and silks stuffs, linens, paper, etc." (*Webster's Revised Unabridged Dictionary*, 1998). A calendered layer is not merely a layer of high density filaments, but instead requires that the filaments are compressed between rollers or equivalent structures. No calendered layer is taught or suggested by Pall. Therefore, claims 5, 7, 11 and 15 are patentable in view of Pall.

CONCLUSION

In view of the foregoing discussion, Applicant respectfully requests notice of the allowance of all pending claims 1-16.

The Commissioner is authorized to charge any additional fees associated with this paper or credit any overpayment to Deposit Account No. 11-0982.

Respectfully submitted,
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